

REMARKS

Claims 1-4 and 32-36 are pending in this application. Claim 2 has been canceled. Claims 4 and 32 have been amended to incorporate the subject matter of claim 2.

Claim 2 has been rejected as claiming the same invention as claim 1 of US Patent 6,492,330. Claim 2 has been canceled.

Therefore, it is respectfully requested that this rejection be withdrawn.

The Examiner rejected claims 1, 3, 4 and 32-36 under the judicially created doctrine of double patenting over claims 1-33 of US Patent No. 6,492,330. Applicants respectfully traverse this rejection.

However, to expedite prosecution, a terminal disclaimer is being filed.

The Examiner has provisionally rejected claims 1, 3, 4 and 32-36 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-27 of copending application 09/630,345. Applicants respectfully traverse this rejection.

The Examiner states that both inventions are basically the same since they are made by the same procedure for the same purpose. There is no legal or factual basis for this statement. Following the Examiner's reasoning could mean that once one patent has been granted for a compound that can be prepared by a standard chemical reaction such as a Diels-Alder reaction and can be used to treat, for example, lung cancer no other patent could be granted for another compound that can be prepared using a Diels-Alder reaction and that can be used for treating lung cancer because there is already one patent for the same purpose.

The Examiner also states that "both inventions are an obvious variation of the other since the same peptides are used for the same purpose, and as such, one of ordinary skill in the art would envision both sets of claims as one invention and obvious variation of each other." Applicants respectfully disagree.

According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

The claims of US Patent application 09/630,345 do not suggest a peptide of the sequence Leu¹-Met²-Tyr³-Pro⁴-Thr⁵-Tyr⁶-Leu⁷-Lys⁸ where at least one amino acid can be replaced by Deg or the subject matter of claims 3,4 and 32 to 36.

In addition, in making this rejection, the Examiner is relying on impermissible hindsight.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See *Panduit Corp. V. Dennison Manufacturing Co.* 227 USPQ 337, 343 (Fed. Cir. 1985):

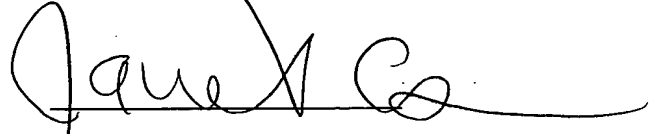
It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. *Vandenberg v. Dairy Equipment*, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing *In re Sponnoble*, 160 U.S.P.Q. 237 (CCPA 1969). In *Uniroyal . Rudkin-Wiley*, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Therefore, it is respectfully requested that this rejection be withdrawn. Applicants submit that the present application is in condition of favorable consideration is respectfully requested.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Janet I. Cord", written over a horizontal line.

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Claim 4 (Amended) A method for treating colon, breast, ovarian, lung or prostate cancer or leukemia comprising administering an effective amount of a peptide [according to claim 3] having the sequence selected from the group consisting of:

Aib-Met-Tyr-Pro-Thr-Tyr-Aib-Lys-OH (SEQ ID NO: 2);
D-Leu-Met-Tyr-Pro-Thr-Tyr-Aib-Lys-OH (SEQ ID NO: 3);
Leu-Met-Tyr-Pro-Thr-D-Tyr-Leu-Lys-OH (SEQ ID NO: 4);
Leu-Met-Tyr-Pro-Thr-Tyr-D-Leu-Lys-OH (SEQ ID NO: 5)
Leu-Met-D-Tyr-Pro-Thr-Tyr-D-Leu-Lys-OH (SEQ ID NO 6)
D-Leu-Met-Tyr-Pro-Thr-Thr-D-Leu-Lys-OH (SEQ ID NO 7);
Aib-Met-Tyr-Pro-Thr-Tyr-Deg-Lys-OH (SEQ ID NO: 8); and
D-Leu-Met-Tyr-Pro-Thr-Tyr-Deg-Lys-OH (SEQ ID NO: 9)

Claim 32 (Amended) A method for treating ovarian cancer, lung cancer or leukemia comprising administering an effective amount of a peptide [according to claim 2] having the sequence selected from the group consisting of:

Aib-Met-Tyr-Pro-Thr-Tyr-Aib-Lys-OH (SEQ ID NO: 2);
D-Leu-Met-Tyr-Pro-Thr-Tyr-Aib-Lys-OH (SEQ ID NO: 3);
Leu-Met-Tyr-Pro-Thr-D-Tyr-Leu-Lys-OH (SEQ ID NO: 4);
Leu-Met-Tyr-Pro-Thr-Tyr-D-Leu-Lys-OH (SEQ ID NO: 5)
Leu-Met-D-Tyr-Pro-Thr-Tyr-D-Leu-Lys-OH (SEQ ID NO 6)
D-Leu-Met-Tyr-Pro-Thr-Thr-D-Leu-Lys-OH (SEQ ID NO 7);
Aib-Met-Tyr-Pro-Thr-Tyr-Deg-Lys-OH (SEQ ID NO: 8); and
D-Leu-Met-Tyr-Pro-Thr-Tyr-Deg-Lys-OH (SEQ ID NO: 9)

to a patient in need thereof.